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Application No. 09/897,823
Response dated 12 January 2004
Response to Office action mailed 20 October 2003

REMARKS AND ARGUMENTS**Rejection of Claim 31 Under 35 U.S.C. § 103**

In paragraph 4 of the present Office action, **Claim 31** was rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,383,170 to Mishima *et al.* in view of U.S. Patent No. 6,120,632 to Dragoo *et al.*

The rejection of **Claim 31** is respectfully traversed on the ground that a *prima facie* case of obviousness has not been established. According to MPEP 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met:

- there must be some suggestion or motivation to modify the reference or to combine reference teachings,
- there must be a reasonable expectation of success, and
- the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The rejection is based on the allegation that “[i]t would have been obvious...to have provided the absorbent article as disclosed by Mishima *et al.*, wherein the gasket cuffs are made of an incrementally stretched laminate, as taught by Dragoo *et al.*, to impart a varying degree of elasticity to the cuff.” It is respectfully averred that this allegation is unsupported both in general and in its details.

As stated in the Office Action, “Mishima *et al.* do not specify that the gasket cuffs could be made of an incrementally stretched laminate.” In fact, this reference fails to even mention anything that is incrementally stretched. Instead, it teaches “elastic members 12a...disposed between the topsheet 2 and the backsheet 3 and secured under tension to at least one of these two sheets 2, 3.” (Column 3, lines 17-20.) The elastic members 12a are clearly shown as small diameter strands of elastic in Figures 1, 2, 4, and 5. This structure is clearly different from the structure of an incrementally stretched laminate.

As also stated in the Office Action, “Dragoo *et al.* disclose an absorbent article having barrier cuffs made of “an activated region” that is preferably formed of an incrementally stretched laminate” (underlining added for emphasis.) Thus, as stated in the present Office Action and as discussed in the response to the previous Office Action, the cited Dragoo *et al.* reference describes barrier leg cuffs including incrementally stretched laminate rather than outer leg cuffs having this structure. As for the outer leg cuffs, as discussed in the response to the previous Office Action, the cited Dragoo *et al.* reference merely references incorporated patents “to illustrate gasket cuffs”.

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Thus, neither of the two cited references provides any suggestion or motivation to modify the Mishima *et al.* reference or to combine reference teachings. Instead, each of the cited references describes or references some form of outer leg cuff without stating or even hinting at an unmet need for a modification or at a desire for a different structure for the outer leg cuff. Similarly, neither of the cited references nor the combination of the two cited references teaches or suggests all of the limitation of the rejected claim.

It is also noted that neither of the cited references discloses any need or desire "to impart a varying degree of elasticity to the [outer leg] cuff." Instead, the alleged desirability of this feature appears to be merely conjecture on the part of the Examiner. In fact, the only basis for the wording in the Office Action appears to be the quotation in the Dragoo *et al.* reference of the title of U.S. Patent No. 5,167,897. It is respectfully averred that the extraction of a phrase from one of three titles of patents quoted in the same paragraph hardly constitutes support for an allegation that the proposed modification is suggested or motivated by the cited references.

In fact, reference to the disclosures of Mishima *et al.* and Dragoo *et al.* leads no farther than to a potential conclusion that the incrementally stretched laminate barrier leg cuffs of Dragoo *et al.* could be substituted for the barrier cuffs of Mishima *et al.* However, such a substitution clearly would not yield the present invention.

Thus, the statement of rejection appears to be merely an allegation that an incrementally stretched laminate could be used for the gasket cuffs of Mishima *et al.* However, as clearly stated in MPEP 2143.01, the mere fact that references could have been combined or modified, or that the level of skill in the art may have been adequate to combine or modify them, is insufficient to establish a prima facie case of obviousness. In addition, given the utter lack of expression in either of the cited references of a need to modify the outer leg cuffs or of a desire to find an alternative outer leg cuff structure, the statement that it would have been obvious to do so is clearly based on nothing more than either conjecture or the application of impermissible hindsight in light of the disclosure of the present invention.

Therefore, the requirements of MPEP 2143 for the establishment of a *prima facie* case of obviousness have not been met. Accordingly, it is respectfully requested that the rejection of Claim 31 under 35 USC § 103(a) be reconsidered and withdrawn.

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Rejection of Claim 35 Under 35 U.S.C. § 103

In paragraph 5 of the present Office action, Claim 35 was rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,613,033 to Popp *et al.* in view of U.S. Patent No. 6,120,632 to Dragoo *et al.*

The rejection of Claim 35 is respectfully traversed on the ground that a *prima facie* case of obviousness has not been established.

The rejection is based on the allegation that “[i]t would have been obvious...to have provided the absorbent article as disclosed by Popp *et al.*, wherein the gasket cuffs are made of an incrementally stretched laminate, as taught by Dragoo *et al.*, to impart a varying degree of elasticity to the cuff.” It is respectfully averred that this allegation is unsupported both in general and in its details.

It is stated in the Office Action that “Mishima *et al.* disclose at least one outer gasket leg cuff (10)” and that “Mishima *et al.* do not specify that the gasket cuffs could be made of an incrementally stretched laminate.” It is respectfully presumed that the intended reference was to the Popp *et al.* reference cited in this rejection, rather than to the Mishima *et al.* reference cited in the rejection of Claim 31 and this response is written on that basis.

Not only does the Popp *et al.* reference fail to specify that the gasket cuffs could be made of an incrementally stretched laminate but, in fact, the Popp *et al.* reference fails to even mention anything that is incrementally stretched. As also stated in the Office Action and as discussed in the response to the previous Office Action, the cited Dragoo *et al.* reference describes barrier leg cuffs including incrementally stretched laminate rather than outer leg cuffs having this structure.

Thus, neither of the two cited references provides any suggestion or motivation to modify the Popp *et al.* reference or to combine reference teachings. Instead, each of the cited references describes or references some form of outer leg cuff without stating or even hinting at an unmet need for a modification or for a different structure of outer leg cuff. Similarly, neither of the cited references nor the combination of the two cited references teaches or suggests all of the limitation of the rejected claim.

It is also noted that neither of the cited references discloses any need or desire “to impart a varying degree of elasticity to the [outer leg] cuff.” Instead, the alleged desirability of this feature appears to be merely conjecture on the part of the Examiner, as noted in the comments with respect to the rejection of Claim 31, above.

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In fact, reference to the disclosures of Popp *et al.* and Dragoo *et al.* does not even lead to a potential conclusion that the incrementally stretched laminate barrier leg cuffs of Dragoo *et al.* could be substituted for any part of the structure disclosed in Popp *et al.* The reason for this shortfall is that the Popp *et al.* reference fails to describe barrier leg cuffs.

Thus, the statement of rejection appears to be merely an allegation that an incrementally stretched laminate could be used for the leg cuffs of Popp *et al.* However, as clearly stated in MPEP 2143.01, the mere fact that references could have been combined or modified, or that the level of skill in the art may have been adequate to combine or modify them, is insufficient to establish a *prima facie* case of obviousness. In addition, given the utter lack of expression in either of the cited references of a need to modify the outer leg cuffs or of a desire to find an alternative outer leg cuff structure, the statement that it would have been obvious to do so is clearly based on nothing more than either conjecture or the application of impermissible hindsight in light of the disclosure of the present invention.

Therefore, the requirements of MPEP 2143 for the establishment of a *prima facie* case of obviousness have not been met. Accordingly, it is respectfully requested that the rejection of Claim 35 under 35 USC § 103(a) be reconsidered and withdrawn.

Allowable Subject Matter

In paragraph 6 of the present Office action, Claims 1, 3, 5-23 and 25-30 were allowed and Claims 32-34 and 36-38 were listed as being allowable if rewritten in independent form. It is respectfully submitted that the latter requirement for rewriting in independent form is not applicable to Claims 32-34 and Claims 36-38 in light of the above arguments averting the allowability of Claims 31 and 35, from which these claims depend.

In particular, as argued above, independent Claim 31 is properly allowable and because Claims 32-34 depend from and thereby contain all the limitations of this claim, these dependent claims are likewise allowable in their present form. Similarly, as argued above, independent Claim 35 is properly allowable and because Claims 36-38 depend from and thereby contain all the limitations of this claim, these dependent claims are likewise allowable in their present form.

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Summary of this Response

No new matter has been added in this response. In light of the above remarks and arguments, it is requested that the objections and rejections be reconsidered and withdrawn and that all of the pending claims be allowed.

Respectfully submitted,

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